**REMARKS:** 

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Claims 2, 11, 13, and 18, and 24-44 have been canceled without prejudice. Claims 1, 3-10, 12, 14-17, and 19-23 are pending in the application.

The Office rejected claims 1 and 3-22 under 35 U.S.C. 102(b) as being anticipated by Bradford 4,345,785.

Applicants note that the pending claims in the present invention are all drawn to methods for providing an anti-rotation member for threaded couplings. One step of the method involves forming a recess in the second connector <u>after</u> the first and second connectors are coupled together.

Bradford 4,345,785 shows two pipe connecting members 12 and 14 coupled by a third retainer housing 16. Bradford's device is a three piece assembly plus anti-rotation members. The ends of Bradford's pipe connecting members 12, 14 opposite from the retainer housing each have threads 12a, 14a for connection to pipelines (not shown). The retainer housing 16 has a threaded hole(s) 17, as disclosed in Figure 3. Although the specification is silent on when the threaded hole 17 is formed, it is clear from the specification column 3 lines 34-36 and Fig. 3 that they are formed prior to the assembly of retainer housing upon coupling the two pipe connecting members because they act as drill guides just prior to receiving set screws 24.

In contrast, the present invention is drawn to a <u>method</u> for threadingly coupling a first pin connector <u>directly</u> to a second box connector, and then removing at least a portion of the second connector <u>after</u> the first and second connectors are coupled together to define a recess in the second connector. Further, there are only two pieces involved in the present invention plus anti-rotation members, as the pin and box sections are connected directly — as compared to the three co-coupled parts of Bradford. Furthermore, the steps of the claimed method are not disclosed by Bradford.

In order to clearly and distinctly point out these important structural and functional differences, between the method of the present invention and Bradford, independent claims 1, 12 and 19 have been amended now to provide for threadingly coupling a first pin connector <u>directly</u> to a second box connector, resulting in a two piece assembly plus an anti-rotation member and claim 1 has been further amended to indicate the anti-rotation device is attached to both the pin and box connections.

Applicants believe that the above amendments and arguments now render independent claims 1, 12 and 19 and the pending dependent claims 3-10, 14-17, and 20-23 allowable over Bradford 4,345,785.

The Office rejected claims 11 and 18 under 35 U.S.C. 103(a) as being unpatentable over Bradford 4,345,785 (as a single reference). Claims 11 and 18 have been canceled now, rendering this rejection moot.

The Office rejected claims 2, 10, 17 and 23 under 35 U.S.C. 103(a) as being unpatentable over Bradford 4,345,785 in view of Miller 4,487,433.

As the Examiner well knows, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Health-care Corp., 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; In re O'Farrell, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Claim 2 has been canceled. Applicants believe claims 10, 17 and 23 are not obvious over Bradford 4,345,785 in view of Miller 4,487,433.

Specifically, Bradford 4,345,785 and Miller 4,487,433 do not show all the limitations of the method claimed in the present invention. In particular, although Bradford and Miller each contain some explanation of the how their individual devices are made, neither disclose the specific steps of the methods of claims 10, 17 and 23 nor their claimed sequence.

Furthermore, since claims 10, 17 and 23 depend from allowable base claims, Applicants believe these claims are also allowable. Accordingly, applicants respectfully request allowance of Claims 1, 3-10, 12, 14-17, and 19-23.

In view of the arguments and amendments made herein, Applicants respectfully submit that the application is now in condition for allowance. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge Deposit Account No. 180584 in the amount of \$1020, the fee required under 37 CFR 1.17(a)(3) for a three month extension for time. It is believed that there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account 180584. If there are any questions concerning the above, please contact the undersigned at (281) 878-5658.

Respectfully submitted,

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